

## **REMARKS**

In the Office Action mailed October 4, 2004, the Examiner noted that claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 20-25 were pending, and rejected all claims. Claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 20-27 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections are traversed below.

Pages 2 and 5 of the Office Action reject all claims under 35 U.S.C. § 103 over combinations of FJCP, Monn and Morag.

As discussed with Supervisor Wellington, the Applicant would like to have an interview with the Examiner on this case as soon as possible.

In the Action the Examiner provided comments concerning the basis for rejection on pages 2-5 and provided comments regarding the prior filed response on pages 6 and 7. A response to each of these sections is provided separately below.

### **Response to Detailed Action of Pages 2-5**

The present invention provides a photographic print medium with both visual images, such as the face of child, and a visual image of printed instructions for assembling a scrapbook page (see claim 1, for example). That is, the invention calls for the medium to include the instructions for making a scrapbook page and the series of pictures to be added to the scrapbook as a composite image on the scrapbook page.

On page 2, the Examiner alleges that FJCP discloses Portrait Greeting Cards and "the ability to provide print mediums with indicia" such as - Happy Easter -. FJCP (a print out of a web page) shows a facsimile of a greeting card that has a picture of a baby and the text words "Happy Easter". However, FJCP does not teach or describe that the picture and the text are on a photographic medium. FJCP does not say anything at all on this issue. As a result, the greeting card could be made of card paper stock with a photograph glued to or otherwise attached to the card paper stock. As can be seen, because FJCP does not even mention how the greeting card is constructed, FJCP does not teach or suggest that indicia, much less scrapbook page creation instructions, be printed on a photographic print medium. The text shown in FJCP could be printed on the card stock since it is shown separated from the baby picture image. Further, for this same reason or deficit in FJCP, FJCP does not teach or suggest that the instructions for making a scrapbook page be printed on the same photographic print medium as the image as is called for in the present invention. Monn does not teach or suggest this deficit in FJCP. Nor does Morag. For this reason it is submitted that the present invention is

patentable over FJCP, Monn and Morag. Withdrawal of the rejection for this reason is requested.

The Examiner bases the rejection on an allegation that FJCP would "Inherently ... include providing instructions on the print medium ... " (see pages 2 and 6). The Examiner is reminded:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art (see Continental Can Co. v Monsanto Co., 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991)).

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient (see In re Olerich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981))

Since FJCP does not teach or suggest printing text on a print medium, much less a photographic print medium, as noted above, instructions on a print medium are also not taught or suggested. Further, greeting cards need no instructions, as it is common knowledge what is to be done with greeting cards and instructions are not necessarily present in the greeting cards described in FJCP. As a result, instructions on a print medium are not inherently included in the greeting cards of FJCP. Monn also does not teach or suggest this deficit in FJCP. Nor does Morag. For this additional reason it is submitted that the present invention is patentable over FJCP, Monn and Morag. Withdrawal of the rejection for this reason is requested.

The Examiner appears to be base the rejection on an attempt to ignore the feature of the invention wherein the visual images for cut out and assembly, and the instructions for such cut out and assembly are provided on the same photographic print medium asserting that there no functional relationship there between. This is not the case. There is a function relationship between the medium and the instructions. As specifically recited in the claims, the instructions tell the user how to deal with the medium, particularly, "allowing the user to manually cut out the series of different characteristics of visual images from the medium in accordance with the instructions". As a result, it would be inappropriate for the Examiner to ignore this feature of the present invention. The Examiner is also reminded that effect must be given to all claim limitations (see In re Angstadt and Griffin, 537 F.2d 498, 190 U.S.P.Q. 214 (C.C.P.A.1976)). For this further reason, it is submitted that the present invention is patentable over FJCP and Monn (and Morag). Withdrawal of the rejection for this additional reason is requested.

The present invention also calls for a "series of images with different characteristics" being printed on the print medium with the instructions. FJCP only shows a single image on the greeting card (see claim 1, for example). Monn adds nothing to FJCP with respect to this

feature. Nor does Morag. For this reason, it is submitted that the present invention is patentable over the prior art. Withdrawal of the rejection for this reason is requested.

As noted above, FJCP is directed to a system for making greeting cards while Monn is directed to a kit for decorating a photo album storage box with paper type cutouts. With respect to the attempt to combine the teachings of these two references the Examiner is reminded:

"[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references . . . . Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

There is no such motivation in this case. FJCP is directed at giving the output produced, a greeting card, to a friend or relative. There is no reason for the user of FJCP to be motivated to remove the images from the greeting card or to otherwise cut-up the greeting card since such would destroy the purpose of the output of FJCP. Greeting cards are not intended to be cut-up. As a result, there would be no motivation to combine FJCP with Monn. For a similar reason, there is no motivation to combine FJCP with Morag. The Examiner is also reminded:

The fact that the prior art teaches away from an invention is evidence that the invention is not obvious (see Akzo v. USITC, 808 F.2d 1471, 1 USPQ2d 1241 (Fed.Cir.1986) and In re Graselli, 713 F.2d 731, 218 USPQ 769 (Fed.Cir.1983)).

In the present situation, the purpose of FJCP of handing complete greeting cards to friends and relatives points or teaches away from cutting up such cards. Thus, the purpose of FJCP teaches away from a combination with Monn. The purpose of FJCP (give cards to friends) also teaches away from Morag (electronic photo album creation). For these further reasons, it is submitted that the present invention is patentable over the prior art. Withdrawal of the rejection for this further reason is requested.

As noted by the Examiner, FJCP has an effective date as prior art of February 7, 2001 (only about 2.5 months prior to the filing date of the above-identified application). It can be demonstrated that FJCP is not prior art to the present invention. As noted in the attached Exhibit which was prepared by the inventor on or about February 16, 2000, a template or prototype example of the present invention had been previously conceived and created. This prototype was part of an extensive list of projects actively being developed by the team of which the inventor was a member. For this additional reason, it is submitted that the present invention is patentable over the prior art. Withdrawal of the rejection for this further reason is requested.

The remaining independent claims 1, 48, 10, 15, 18, 20, 23 and 25-27 also emphasize similar distinctions over the prior art. In particular claims 26 and 27 emphasize that there is a specific correlation between the images of the series of images and the instructions for assembling the scrapbook page where this is shown and described with respect to figure 1B of the application. Nothing in the prior art teaches or suggests such. It is submitted that the claims distinguish over the prior art.

#### Response To Comments of Pages 6-7

On pages 6 and 7 of the Action, the Examiner has mischaracterized the arguments made by the applicant as well as the teachings of the prior art, as discussed below.

On page 6, the Examiner states:

Applicant argues that FJCP does not teach or disclose that the picture and the text are on a photographic medium.

In fact what the applicant has argued is that that FJCP does not teach or disclose that both the picture and the assembly instructions are formed on a single or contiguous piece of photographic medium. The Examiner, via this mischaracterization, predisposes the invention to her arguments by her use of words like "the picture and the text are on a photographic medium" thereby not considering the invention as a whole.

The Examiner then asserts:

The examiner maintains that it is notoriously well-known to provide pictures of the kind disclosed by FJCP on a photographic medium. FJCP does not disclose the greeting card being made of card stock with a photograph glued to or otherwise attached to the card paper stock. Clearly, the pictures of FJCP are on the photographic medium.

This in effect has again not considered the invention as a whole.

The Examiner again mischaracterizes the invention in the following paragraph stating:

Applicant argues that FJCP fails to disclose printing instructions on the photographic print medium.

This in effect dilutes or ignores the true language of the claims. The language of the claims do not call for "printing instructions" and instead call for "printed instructions for making the scrapbook" (claims 1, 48, 10, 15, 18 and 20), "instructions ... containing information for assembling said at least one user supplied digital image" (claim 23), and "scrapbook page assembly instructions" (claims 25-27). This is very different from the characterization by the Examiner.

The Examiner maintains, incorrectly, that a greeting such as Happy Easter is equivalent to the explicit language used in the claims of the present invention. In the Examiner's words, "...including providing instructions on the print medium, since it would only depend upon the intended use of the print medium and the desired information to be displayed." There has been no demonstration in the cited art where the intended use is that the text printed with an image describes how to create a further finished or second product by following the contiguous printed assembly instructions and destroying the first product in the process.

The Examiner also states:

The examiner maintains that FJCP disclose that it is well known to provide any desired printing (for example, "Happy Easter") on the photographic print medium.

This is a mischaracterization of the prior art. FJCP does not allow the user to provide "any desired printing but rather constrains the user to the selections of the web page noted by the check boxes shown as circles, "O", that are "filled-in" by the user.

The Examiner then bases the rejection on the conclusion:

The examiner maintains that the sole difference between the present invention and the photographic print medium disclosed by FJCP is in the content of the printed matter. Accordingly, there being no functional relationship between the substrate and the printed matter, as disclosed above, there is no reason to give: patentable weight to the printed matter which, by itself, is non-statutory subject matter.

The Examiner has ignored the functionality between the printed assembly instructions and the medium and the content of the medium found in the claims, for example:

printed instructions for making the scrapbook on the single photographic print medium; allowing the user to manually cut out the series of different characteristics of visual images from the medium in accordance with the instructions; and allowing the user to manually fix the cut out different visual images on the page forming a composite image on the page in accordance with the instructions which can be used in the scrapbook

(claim 1)

It is submitted that the invention of independent claims distinguishes over the prior art and withdrawal of the rejection is requested.

The dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the prior art. For example, claim 11 calls for the series of images to have different characteristics to be a single image. The prior art says nothing about this. Claim 21 calls for making payment over the channel via which images from the user to the service provider are transmitted. Nothing in the prior art addresses this. It is

submitted that the dependent claims are independently patentable over the prior art.

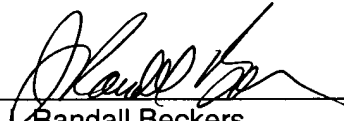
It is submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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Date: 12/15/74

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